APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,698	10/17/2000	Guy Nathan	871-95	1505

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EXAMINER
SHAH, MILAP

ART UNIT	PAPER NUMBER
3714	

NOTIFICATION DATE	DELIVERY MODE
07/09/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

	Application No.	Applicant(s)
Office Action Summary	09/688,698	NATHAN ET AL.
	Examiner	Art Unit	
	Milap Shah	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>08 April 2008</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>12,15-20 and 22-24</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>12,15-20 and 22-24</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All   b) ☐ Some * c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail. Date _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

This action is in response to the amendment received on April 8, 2008. The Examiner acknowledges

that claims 12 & 19 were amended, claim 21 was canceled, and claim 24 was added. Therefore, claims 12,

15-20, & 22-24 are currently pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections

set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of
> this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter
> as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which
> said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 12, 15, 19, 20, & 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin

et al. (U.S. Patent No. 5,848,398, of record) in view of John Rocket's Name That Tune (of record), Tom and

Liz's Name That Tune (of record), Winksy et al. (U.S. Patent No. 5,739,451, of record), and further in view

of Owens et al. (U.S. Patent No. 6,315,572).

Claims 12, 15, & 19: Martin et al. disclose the invention substantially as claimed including a method

and apparatus for managing a plurality of computerized jukeboxes at different locations from a

remote central station, where the remote central station maintains a host computer having a master

library of songs stored in a bulk storage unit. Each "jukebox" maintains a subset song library of the

master library of songs and updates with new songs and menus by simply downloading the data via a

transmission link. In one embodiment, the computerized jukebox conducts an electronic game.

Martin et al. specifically disclose:

a remote server (figure 1[central management system 11]) and at least one terminal (figure

1[jukebox 13]) operable to communicate with the server over a communications network (figure

1[transmissions link 15]), wherein the terminal includes an audio system (figure 1[audio reproduction circuit 127 and speakers 129]) for playing at least a portion of a musical recording (abstract, column 1, line 66 – column 2, line 51, and column 3, line 15 – column 4, line 40; also note: "for the needs of the game" is interpreted as intended use and is given no patentable weight); and

the terminal is operable as a jukebox system that includes a storage device (figure 1[optical memory 93]) that stores a library of musical recordings that can be played in full on the jukebox for a fee (figure 5[step 167]), and further wherein the library of musical recordings can be updated with additional musical recordings through communication with the server, thereby defining a customized library of musical recordings on the jukebox system (*id.*, column 4, lines 58-63, column 5, lines 40-57, column 6, lines 8-18 & 45-52, and column 7, lines 39-57).

Martin et al. appear to explicitly lack in disclosing:

(i) a display that displays information in the form of a question and suggests multiple choice answers to the question, where the question relates to the portion of the musical recording that has been played;

(ii) a user interface enabling the player to play the game and a scorer for recording an answer selected and determining if said answer corresponds to a correct answer;

(iii) the jukebox system having a game module operable to automatically control the updating of the customized libraries of musical recordings stored in the jukebox system with musical recordings stored on the remote server, through a communications link (as noted above, "for the needs of the game" is considered intended use and is given no patentable weight);

(iv) the jukebox system being operable to randomly select the musical recording for the game from the customized library of musical recordings;

(v) the jukebox system being operable to randomly generate a question about the selected recording to provide a correct answer relating to the question and a number of wrong answers relating to the question; and

(vi) the jukebox system sends information to the server regarding how the user performed during the game.

While, many of the above specific intended uses of the entertainment system may be construed as merely intended use of an apparatus having the necessary structure operable to perform such intended use (i.e. the entertainment system's structure), the Examiner will nonetheless explain how these features are well known in the prior art.

A popular, old, and well known game entitled "Name That Tune" has been known for many years to provide players with excerpts of songs and the means to allow players to provide a correct answer as to a question relating to the selected song. Prizes and awards may be offered for a number of correct answers or simply a score or points. "Name That Tune" was also a popular game show in the early 1950's. There have been numerous versions of "Name That Tune" adopted in various forms such as on stand-alone computer systems or over the Internet as an Internet game, or the like.

Thus, the Examine submits the following three references: "Johnny Rockets Name That Tune" and "Tom and Liz's Name That Tune" that are directed to variants of the "Name That Tune" game including various features and Winksy et al. directed to a music trivia game. These references are considered analogous art to Martin et al. because all are computerized games associated with music and response to the play of musical recordings. Each reference provides a trivia music type game for the enjoyment of a player. Those skilled in the art having ordinary skill and common sense would have found it to be mere routine skill in the art to interchange known features of music trivia games to create obvious variants of such.

Johnny Rocket's Name That Tune discloses at least the missing limitations (i), (ii), and (vi) discussed above, specifically, Johnny Rocket's Name That Tune teaches:

a display that displays information in the form of a question and suggests multiple choice answers to the question (see questions 1-5), wherein the question relates to the portion of the musical recording that has been played;

a user interface (i.e. the webpage and a player's personal computer having at least a mouse and keyboard for interacting with the webpage) that enables a user to select an answer from the displayed multiple choice answers and a scorer for recording the answer selected by the user and determining if the answer corresponds to a correct answer (How Did I Do?, page 2); and

the jukebox system sends information to the server regarding how the user performed during the game (i.e. the information must be sent to a server to determine how the player when the player selects "How Did I Do?").

Tom and Liz's Name That Tune discloses at least the missing limitation (iii) discussed above, specifically Tom and Liz's Name That Tune teaches:

a game module (i.e. program code) automatically controlling the updating of the customized libraries of musical recordings stored on the jukebox system with musical recordings stored on the server for the needs of the game.

Tom and Liz's Name That Tune discloses a music trivia game that updates weekly (pp 1 of 10). The music for the game must be the same for all systems on the network. Martin et al also disclose the ability for the central station to automatically transmit songs to the jukeboxes as needed. Thus, in implementing the updating of the libraries based on needs of the game would utilize this ability to automatically transmit songs as needed.

Winksy et al. disclose at least the missing limitation (iv) discussed above, specifically Winksy teaches randomly selecting a musical recording for a game from the customized library of musical

recordings. Winksy et al. disclose a musical trivia game wherein musical recordings are stored onto memory of a controller and the recordings may be randomly selected for use in a trivia game (column 7, line 28 – column 8, line 30). Winksy is further analogous in that it not only randomly selects a musical recording, but selects to make audible only a portion of the musical recording and obtain responses from players as to information related to the song (i.e. questions are asked in relation to the songs randomly selected).

As discussed above, Martin et al., Johnny Rocket's Name that Tune, Tom and Liz's Name That Tune, and Winksy et al. are all analogous art directed to music recordings. Those of ordinary skill would have been motivated to apply the teachings of Johnny Rocket's Name That Tune to Martin et al. because the features of the this variant of Name That Tune provides an entertaining game and would further provide an additional source of profit for Martin's computerized jukeboxes when in a game mode, thereby increasing revenue for game operators. Those of ordinary skill in the art would also have been motivated to apply the teachings of Tom and Liz's Name That Tune variant because providing updating music libraries that change often provide a user experience that changes regularly, thereby increasing player retention and player interest as the songs and questions are regularly altered. If such did not occur, the game would get boring quickly to those players that would have exhausted the full library of songs. Consequently, to add more randomness to the trivia game, those of ordinary skill in the art would have been motivated to implement the teachings of Winksy et al. into the obvious variant of the Name That Tune game as discussed above, where providing randomness as to which songs are selected introduces mystery, suspense, and increases the overall excitement of the player. Such features would have been extremely beneficial in achieving a successful jukebox trivia game. Jukeboxes are known to be in places where people gather (i.e. restaurants, bars, or the like), thus, it would be beneficial to have dynamically changing content with randomness in the game play, as the patrons using such jukeboxes may be repeat customers who

would appreciate a varied gaming experience each time the game is played. Thereby increasing both player retention in the game mode of the jukebox and revenue from such a game mode.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Martin et al. with the teachings of Johnny Rocket's Name That Tune, Tom and Liz's Name That Tune, and Winksy et al. to incorporate the features of various music trivia games such as those variants of the old and well known game "Name That Tune" into a game mode of Martin et al to provide to those users of the Martin et al. invention an exciting known game utilizing the stored musical recordings available on the jukebox systems. Such games are proven to be successful and assist in retaining customers or players, thereby increasing revenue of the jukebox system. It's fairly commonplace for a person to use a jukebox for a few minutes to select some songs then leave the jukebox, however, with the implementation of the Name That Tune game as discussed by these two references, would assist in retaining the users at the jukebox system whereby additional fees for playing the game could be received to increase revenue.

In accordance with the above discussion, the combination of Martin et al., Johnny Rocket's Name That Tune, Tom and Liz's Name That Tune, and Winksy et al. disclose the invention substantially as claimed except for explicitly disclosing the missing limitation (v) discussed above, where the jukebox system randomly generates a question about the selected recording, to provide a correct and multiple wrong answers relating to the question.

It is noted that each of the three secondary references discussed above disclose questions being asked in response to a musical recording being played. Thus, it would have required mere routine skill in the art to pursue known techniques in authoring or developing questions for either a question bank (i.e. predetermined questions stored in memory) or for on-the-fly generation of questions. Owens et al. teach a method and system for computerized authoring of multiple choice questions. In one embodiment Owens et al. teach that multiple choice questions can be randomly

generated, where each randomly generated multiple choice question includes three parts, first being

the question itself, second part being a correct answer to the question and, third being one or more

wrong answers to the question. Owens et al. teach that in general, the question generation process

pulls these parts from a database of stored information (column 20, line 43 - column 21, line 28).

Owens et al. further disclose their system is useable for the objective of determining the aptitude of

a user in answer questions for a particular lesson, topic, subject, or the like, where even scores are

recorded (see Summary of Invention). In implementation of an equivalent concept into the

combination of references discussed above, the various information (i.e. artist, song title, release

year, etc.) of the musical recordings stored in the customized library would also be stored (i.e. simply

as a format of file name, where information can be pulled from a filename if need be). Thus, upon

activation of the question generation process, various information is pulled from the database or

customized music library to present randomly generated multiple choice questions to the users of

the trivia game, thereby providing these users with yet another level of randomness and variety such

that no two gaming experiences are identical, thereby also increasing player retention and game

revenue of the jukebox system in a game mode. Owens et al. also disclose a primary advantage of

their system is the ability to generate questions from lesson data randomly without someone

manually authoring questions related to a lesson. The same concept is applicable in a jukebox system

that has a customized music library that changes regularly, thereby not requiring any administrator to

manually create questions for the trivia game, which again, provides yet another benefit in providing

a music trivia game that can virtually never have the same sequence of trivia questions, thereby

creating a varied and unique gaming experience each time the game is run. Lastly, the above

provides motivation, however, it could be argued that Owens et al. invention is non-analogous,

however, it should be noted that the art of question generation is specifically an educational art,

thus, those skilled in the art designing trivia games would have possessed the common knowledge to

review education related art in designing a music trivia game, as even a music trivia game is considered to be educational.

Therefore, for at least the reasons provided, it would have been obvious to modify the combination of Martin et al., Johnny Rocket's Name that Tune, Tom and Liz's Name That Tune, and Winksy et al. with the teachings of Owens et al. in order to create a music trivia game on a networked computerized jukebox system whereby no two gaming experiences would be identical as the game would include many aspects of randomness from random song selection to random generation of the questions to be asked in response to the random selection of the song.

Claim 20: Owens et al. also discloses a process of randomly selecting questions from a list of already generated questions (*id.*). Winksy et al. also disclose randomly selecting from a list of stored predetermined questions (column 7, lines 53-56). Either of these provides a teaching of randomly selecting a question from a predetermined list of questions (i.e. similarly to what many question-answer type games generally do).

Claims 22 & 23: Winksy et al. disclose randomly selecting a portion of the selected recording for playback to the user (column 7, lines 28-54), further, where this selection is based on at least one predetermined criteria such as the song to be selected must be stored/saved on the system. Both of the Name That Tune variations applied above also, by their game play, select portions of songs to be played back to the user. Thus, any of these are equivalent teachings of implementing such a feature.

Claim 24: Owens et al. disclose a storage device that stores and categorizes information relating to a lesson and wherein the randomly generated questions relate to at least one category of information, wherein the randomly generated wrong answers are select from within the same category (i.e. as clearly seen in figure 9 - during the manual generation process a user can select a correct answer and multiple incorrect or distracting answers from the same category of information, where the random generation of multiple choice questions operates similarly). Therefore, as discussed above with

respect to the various information of musical recordings stored in the customized database, it would

have been obvious to pull the same category of data from different songs similarly to the teaching of

Owens et al to formulate random multiple choice questions having a correct and multiple wrong

answers from the same category of stored information (i.e. song titles, artist names, etc.). It would

have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to

incorporate the teaching of Owens et al. as discussed and further to implement such for musical

recordings to obtain the invention as specified in claim 24.

    Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al., John

Rocket's Name That Tune, Tom and Liz's Name That Tune, Winksy et al., and Owens et al., as applied to

claims 12, 15, 19, 20, & 22-24, where applicable, further in view of "Official Notice".

    Claims 16-18: The combination of Martin et al., Johnny Rocket's Name That Tune, Tom and Liz's

Name That Tune, Winksy et al., and Owens et al. disclose the invention substantially as claimed

except for explicitly disclosing a server collecting user performance information, ranking the users,

and transmitting an indication of the ranking to each of a plurality of different players playing an

equivalent music trivia game. While, it appears that the prior art applied, such as Tom and Liz's

Name That Tune discloses collection of performance data and ranking, however it appears that the

"server" does not explicitly perform such a task. However, such a game feature of collecting

performance data from a plurality of players, ranking the players based on performance, and

transmitting such indications back to their user terminals for display is notoriously well known in the

art in many aspects of gaming such as older arcade games, mobile games on cellular phones, or

Internet based games. Thus, the Examiner takes "Official Notice" that such game features were

notoriously well known and those of ordinary skill developing games, such as music trivia games,

would have found it well within their ordinary level of skill and common knowledge to implement

such features. Further Martin et al. disclose multiple different jukeboxes in different areas, thus, even

if these players play their games individually, a global high score light is also notoriously well known

in the art. The Examiner will respectfully submit evidence upon this Official Notice being

challenged, however, at this time it appears that such game features are well known enough that

evidence is unnecessary. Motivation to include such features is simple in the competitive nature of

humans, such that players simply want to know if they're on top of the rankings or not, and if

they're not, they'll try even harder to get there (thereby spending more money on the jukebox).

Therefore, it would have been *prima facie* obvious to modify the combination of Martin et al.,

Johnny Rocket's Name That Tune, Tom and Liz's Name That Tune, Winksy et al., and Owens et al.

to obtain the invention as specified in claims 16-18.

Response to Arguments

Applicant's arguments with respect to claims 12, 15-20, & 22-24 have been considered but are moot

in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The Examiner has cited some additional prior art for review, see the attached "Notice of References Cited".

Any inquiry concerning this communication or earlier communications from the examiner should be

directed to Milap Shah whose telephone number is (571)272-1723. The examiner can normally be reached

on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert

Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this

application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application

Information Retrieval (PAIR) system. Status information for published applications may be obtained from

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/Robert E Pezzuto/
Supervisory Patent Examiner, Art Unit 3714

/MBS/